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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/372,560 08/11/99 VANCURA

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EXAMINER

QM12/0117

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ART UNIT

PAPER NUMBER

3711

DATE MAILED:

01/17/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/372,560

Applicant
Vancura

Examiner
William M. Pierce

Group Art Unit
3711



☒ Responsive to communication(s) filed on Dec 20, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-87 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-87 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

WILLIAM M. PIERCE
PRIMARY EXAMINER

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the steps of the claim must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Steps, such as in claims 5-11, 14-18, 48, 49, 55, 56, 59, 60 and etc. Applicant is to review the claims to be certain the each step recited therein is illustrated.

Applicant points to Keller. However, the prosecution of Keller is independent of the instant prosecution. It is consistent to require that "each and every feature of the invention specified in the claims" be shown and such is required here. The applicant's position that the drawing are "sufficient. MPEP 601.01(g) is not dispositive since it relates to applications filed without figures or drawing and not to supersede 37 CFR 1.83(a). Where it discusses "PTO practice..." as quoted by applicant is not certain. Applicant has not pointed to where specifically he refers and to which version of the MPEP. It is submitted that applicant is using an older version. 35 USC 133 relates to Time for prosecuting applications and has nothing to do with the drawing requirements. Hence, applicant's position is weak and the objection remains.

2. Claims 1-87 were rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It stated that, "In the specification, the game of chance is played "separately" form the bonus game and is not play in "combination" which implies the games are played simultaneously.

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To clarify this rejection for applicant. The claim merely calls for the "playing the knowledge-based bonus game in combination with the bonus game". The scope of the claim implies that the games are played at the same time and not sequentially after one another as disclosed. Note fig. 2 where the flow chart shows the steps of the method to go from "play underlying casino game", "stop play" and then to "play knowledge-based bonus game". This is a scope of claim problem. In his remarks applicant points to Marnell to clarify the term in "combination". However, examiner will not read such "interpretations" into the instant claims and it is submitted that the claim be amended to clarify its scope such that it reflects the invention set forth in the specification.

3. Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, in line with the rejection under 1st paragraph set forth above, the scope of the term "playing...in combination" recited in claim 1 is not clear. As set forth above, this is a scope of claim problem. It leaves the claim inferential and unclear since the steps required to play these games "in combination" are not recited.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless --

5. Claims 1-7, 12, 13, 18, 42-46, 50, 55, 57 and 58 are rejected under 35 U.S.C. 102(b) as being anticipated by Keller and, in the alternative 2,197,974.

Claims 1-4, 41-46, 50, 57 and 58 are clearly shown. In Keller and '974, the game of chance stops when a prize has been determined or rewarded. At that point, the game of skill commences. As to claim 5, stopping the game of chance when the condition of a prize being identified is shown. As to claim 6, the game of chance stops at the end of the game. The end of each game of chance is considered to be a "given frequency" as called for in claim 7. As to claims 12 and 13, a player is "payed" a prize in Keller and '974. Claims 18, 41 and 55 are shown in that a player is payed a first prize if correctly answers and receives a second amount of no prize if incorrectly answers

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 8-11, 14-17, 19-40, 47- 49, 51-54, 56 and 59-87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keller and/or 2,197,974 in view of Thompson.

As to claims 8, 47 and 61, neither of the above references show random stopping of the chance game. Thompson teaches that it would have been obvious to random conduct the steps of

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a game like those shown by Keller and '974 in order to add an element of surprise to the players. The setting of the house advantage in claim 9-11, 19, 20, 25-35, 48, 49, 56, 59, 60, 62, 64 and 65-69 are obvious matters of design choice. As to claims 14, 21 and 22, it is considered an obvious matter of design choice to require either an exact answer or a proximate answer that is "close enough". Similarly, allowing a player to have more than one chance to answer a query and paying out accordingly as called for in claim 63 is old and not considered an advance in the art. To have only required a proximate answer in Keller of '974 would have been obvious in order to make it easier on the player. As to claims 15-17, 23, 36-40 and 51-54, Keller and '974 show "trivia" and a "quiz". Multiple choice, puzzles and true/false questions are all well known examples of such trivia or quiz type games of skill that are known in the art. To have selected one would have been an obvious matter of design choice. Claim 24 is shown in that a player is paid a first prize if correctly answers and receives a second amount of no prize if incorrectly answers. Claims 70-79 and 82-85 are old to trivia type games. Claims 80, 81, 86 and 87 are treated as set forth above.

A. Response to Applicant's remarks set forth on pg. 13-15 are set forth in the rejections set forth above.

Examiner notes exhibits and applicant's remarks thereto made on pgs. 15-18.

B. Applicant opposes the application of Keller stating the he "teaches only a skill game and not as a game of chance." This is not true. Keller shows playing a game of chance in the "casino

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game". This is combined with a "mental-skill game" to be subsequently played. It appears applicants remarks are based upon a misunderstanding of the teachings of Keller. Keller is attempts to combine two games so that the game cannot be considered only a game of chance and thus illegal by many states. By combining them with a game of skill, his game would not be barred by these statutes of law. In Keller, a player place a wager and receives a payout in tokens like a standard casino game. However, the tokens are not given any cash value and are only good for chances to play the game of skill. Specifically turning to claim 1, the steps of "receiving a wager" are shown in fig. 1 of Keller by "players can place stake in a casino game", "playing an underlying game of chance" is shown by "conduct casino game" and "playing a knowledge-based bonus game." by "conduct skill game. The house advantage is at the bottom of col. 2, lns 61-67 where a player is played "for the entertainment". The house advantage is nothing more than a percentage of the wager retained by the house for the privileges of playing the games. In view of the above, Keller meets the limitations of the claims. Applicant's final arguments amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

C. Applicant opposes '974 since he claims that it does not show a "casino game of chance". However, claim 1 only calls for a "game of chance". Even so a "slot machine" is considered a "casino game" albeit not played with a table layout. In '974, the game of chance is played to determine payout or prize and then the game of skill is played to see if player is awarded that payout. Hence, the scope of Applicant's claims fail to distinguish over this reference.

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E. Claim 5 merely calls for the stopping of the play of the game of chance based upon a condition. In Keller and '974 the game of chance is stopped when a winning stake is rewarded to a player. Thus, claim 5 read into claim 1 is shown by both applied references.

Claim 6 broadly defines stopping the game "based upon a condition occurring unrelated to the play of the underlying game of chance". Awarding a stake to a player is not considered to be "related" the game of chance. Further, merely because applicant's interpretation of the claims and the applied art differs from that of the examiner does not preclude a final rejection being made.

As set forth in examiner's position above, Keller and '974 show a game of chance. The frequency of stopping the game is every time a stake is rewarded to a player.

In both Keller and '974, a prize is payed as called for in claim s 12 and 13. Claim 12 merely calls for "paying the player based upon the at least on answer". These limitation do little to further limit the scope of claim 1 which fairly reads on Keller and '974.

Applicant's arguments with respect to claims 18, 31, 35, 41, 50 and 55 fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Both Keller and '974 are appropriately applied under 103 for the reasons set forth above. Applicant points to the specification to define the concept of "frequency". However, this fails to distinguish over the art of record since the examiner cannot read limitation from the specification into the claims. The claims are afforded their broadest reasonable interpretation. Casino games

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like Keller need a "house advantage" because that is the percentage of profit worked into the game. For a gaming operator to make money the game must contain a "house advantage". No limitations in the claims preclude the term "given frequency" from reading on the teachings of Thompson.

The "house advantage" is an old and well known concept to one of ordinary skill in the art. This is not a discovery of the applicant. The "house advantage" is a matter of choice and considered to be a balance between profit and player interest. The higher the "house advantage" (i.e. profit) the less player interest. In examining the claims, skill is presumed on the part of those practicing in the art. See *In re Sovish*, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985). The desire of a game designer to make a profit at playing the game as well as maintaining a player interest is presumed. In line with that, we must also take into account the not only the specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. *In re Preda*, 401 F.2d 825, 826 159 USPQ 342, 344 (CCPA 1968). Clearly we can expect that a game designer would avoid a game where the overall payouts are not profitable when compared to a players wagers. Such "payouts" are discussed in applicant's own C1 exhibit, for example.

The acceptance of a "proximate answer" or allowing more than one guess relates only to question and answer games. Certainly applicant is not the first to consider awarding a player based on who is the closest or allowing a plurality of guesses at the correct answer.

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Remarks with respect to claims 70-79 and 80-87 amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

In conclusion, it is incumbent upon the examiner to give the claims their broadest reasonable interpretation. As set forth in the rejection above, the claim limitations set forth fail to positively distinguish over the art of record.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication should be directed to William Pierce at E-mail address bill.pierce@USPTO.gov or at telephone number (703) 308-3551.


WILLIAM
PRIMARY EXAMINER